



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/982,488	10/17/2001	Jeffrey Skolnick	10886-045002	7996
20985	7590	11/19/2004		
FISH & RICHARDSON, PC 12390 EL CAMINO REAL SAN DIEGO, CA 92130-2081			EXAMINER CLOW, LORI A	
			ART UNIT	PAPER NUMBER
			1631	

DATE MAILED: 11/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/982,488

Applicant(s)

SKOLNICK ET AL.

Examiner

Lori A. Clow, Ph.D.

Art Unit

1631

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 28 October 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 28 October 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 9-11.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: See Continuation Sheet

Continuation of 2. NOTE: The proposed amendments to the claims introduce new limitations that were not previously considered and herefore would require further search and consideration. For example, in step (vii) "selection of interaction centers to minimize the distance of the projected chain" was not previously considered.

Continuation of 10. Other: Further, Applicant's response and amendments to claims 9-11 fail to overcome the art of record. Claims 9-11 remain rejected under 35 U.S.C. 102(a) as being anticipated by Kolinski et al. (Proceedings of HRCL Workshop on Monte Carlo Approach to Biopolymers and Protein Folding. (1998) P. Grassberge et al., Eds., World Scientific, Singapore/London, pages 100-130:PTO-1449, reference AI), for the reasons set forth in the previous Office Action. Claims 9-11 remain rejected under 35 U.S.C. 102(a) as being anticipated by Kolinski et al. (J. Phys. Chem. (1998) Vol. 102, pp.4628-4637:PTO-1449, reference AJ), for the reasons set forth in the previous Office Action. Applicant argues that "the computer implemented methods of the instant invention use a force field designed entirely of a knowledge-based" origin. This is not persuasive, for the reasons set forth previously. It is clear that the method of Kolinski et al. is directed to a reduced protein model that is based upon lattice representations of protein side chain centers of mass (see Discussion; HRCL Workshop). Further, in Kolinski et al. (J. Phys Chem.) Kolinski et al. clearly state that this is a "knowledge based" approach and that they employ only a homology approach using small fragments of protein sequences. The purpose of the work was to analyze the role of generic proteinlike regularities seen in protein chains, the role of sequence-specific short-range correlations of the side chain positions, and this interplay. They demonstrated that the proposed model provided an efficient tool for modeling protein secondary structure (see page 4628, column 1).

Lu A. Claw
16 November 2004

MARJORIE MORAN
PATENT EXAMINER

Marjorie A. Moran
11/16/04